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9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
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12 3COM CORPORATION,)
13 Plaintiff(s),)
14 v.)
15 D-LINK SYSTEMS, INC.,)
16 Defendant(s) .)
17 _____)

No. C03-2177 VRW (BZ)

**ORDER ON MOTION TO STRIKE
PLAINTIFF'S AMENDED
PRELIMINARY INFRINGEMENT
CONTENTIONS**

18 Defendant Realtek Semiconductor Corp. has moved to strike
19 plaintiff's Amended Preliminary Infringement Contentions
20 (Amended Contentions) served September 16, 2005. The thrust
21 of Realtek's argument is that the Amended Contentions do not
22 contain the level of specificity required by Patent Local Rule
23 3-1.

24 Although the motion seeks to strike the entire 42 page
25 set of Amended Contentions, in its argument, Realtek focuses
26 on 3 deficiencies. The first is with respect to Claim 26, of
27 the '446 patent which has as an element "using said descriptor
28 signal to generate a frame segment descriptor using a

1 segmentation circuit." 3Com's Amended Contention states that
2 the accused products include a "segmentation circuit to
3 generate a frame segment descriptor. See 8169 Spec. at 5."
4 Realtek argues that the 8169 Specification "cannot be
5 interpreted to mean that the RTL 8169 uses this specific,
6 elaborate process....Realtek's products simply do not
7 "generate a frame signal descriptor" at all" (Memo 7:17-20).

8 As this court has previously noted:

9 While NCT's responses may not be an exemplary model
10 of disclosure, Patent LR 3-1 does not require NCT to
11 produce evidence of infringement or to set forth
12 ironclad and irrefutable claim constructions.
13 Rather, Patent LR 3-1 is "designed to require
14 parties to crystallize their theories of the case
15 early in the litigation and to adhere to those
16 theories once they have been disclosed." [Citations]
17 Whether those theories may ultimately be vindicated
18 through claim construction and at trial is an
19 entirely separate matter from whether Patent LR 3-1
20 has been satisfied. At this juncture, a party may
21 comply with Patent LR 3-1 by setting forth
22 particular theories of infringement with sufficient
23 specificity to provide defendants' with notice of
24 infringement beyond that which is provided by the
25 mere language of the patents themselves. Network
26 Caching Technology, LLC v. Novell, Inc., 2003 WL
27 21699799 at *4 (N.D. Cal. March 21, 2003).

19 Here too, the most Realtek's argument establishes is that
20 it may prevail on this claim. Realtek has not established
21 that the Amended Contention lacks the specificity required by
22 Patent Local Rule 3-1. At the same time, I interpret the
23 Patent Local Rules as precluding 3Com from using information
24 at trial which should have been provided as part of its
25 Amended Contentions but was not. In its opposition, 3Com
26 states that had it been aware of Realtek's concern, it could
27 have "directed Realtek to page 3 of the RTL 8169
28 specification" (Opp 6:13) which contains additional

1 information, and not page 5. I believe that the deficiency
2 chart attached to Yang's October 31, 2005 letter put 3Com on
3 sufficient notice of Realtek's concern such that when 3Com met
4 and conferred with Realtek, 3Com should then have proffered
5 the additional information it now offers.

6 The second claimed deficiency is with respect to Claim 1
7 of the '884 patent. An element of that claim is "a first port
8 on which incoming data is received at a data transfer rate."
9 The Amended Contention is that each of the accused products
10 has a "port or ports operable to receive data from a network.
11 See 8169 spec at 4-5." While this specification is not before
12 me, Realtek claims and 3Com does not deny that the
13 specification fails to disclose what structure depicted on
14 that specification constitutes the first port. In its
15 opposition, 3Com merely states that "by their very nature, the
16 accused products must contain" (Opp 6:27) such a port and that
17 it "must be between the computer and the network" (Opp 7:3).
18 The Local Patent Rules are not satisfied by an assertion that
19 the accused product must contain a certain structure.
20 Instead, 3Com must specify which structure constitutes the
21 first port.

22 The third claimed deficiency involves Claim 23 of the
23 '625 patent. An element of that claim is "a buffer coupled to
24 the first and second ports which stores data packets from one
25 of the first and second ports in an order of receipt, said
26 packets identifiable as having respective packet types from a
27 plurality of packet types." Realtek complains that in its
28 view, nothing in the Amended Contention "suggests that the two

1 [described structures] are coupled to a first or second
2 port...or stores data packets from one of the first and second
3 ports in an order of receipt." (Memo 9:4-6). Once again, this
4 merely establishes that Realtek may prevail; not that the
5 disclosure is inadequate.

6 As to the rest of the Amended Contentions, having
7 reviewed them without the benefit of specific argument
8 directed to the claimed deficiencies, they appear to provide
9 Realtek with "notice of infringement beyond that which is
10 provided by the mere language of the patents themselves." As
11 I have previously suggested to the parties, many of these
12 problems could have been resolved had the parties met and
13 conferred in good faith with the goal of resolving their
14 problems rather than preparing for a motion.¹ Without
15 offering a view as to who has misbehaved, it is disturbing to
16 read 3Com's complaint that had Realtek truly expressed its
17 concerns, 3Com would have provided more information. At the
18 same time, 3Com should bear in mind that the meet and confer
19 process imposes obligations on both parties to resolve
20 outstanding issues and that withholding information which a
21 party should have produced should have produced may be grounds
22 for excluding that information at trial.

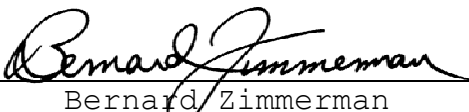
23 Alternatively, I suggested that some of Realtek's
24 concerns could be resolved by a 30(b)(6) deposition of someone
25 most knowledgeable about 3Com's contentions. Nonending

27 ¹ Significantly, Realtek did not lodge a record of the
28 meet and confer session as required by my Seventh Discovery
Order.

1 disputes about the adequacy of a set of contentions as
2 detailed as 3Com's is not the best way of resolving Realtek's
3 concerns.

4 For the foregoing reasons, **IT IS ORDERED** that Realtek's
5 motion is **DENIED** except that within 14 days of this Order,
6 3Com shall further amend its contention with respect to Claim
7 1 of the '884 Patent.

8 Dated: January 9, 2006



Bernard Zimmerman
United States Magistrate Judge

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